

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Bashiri, Phung, Ramzipoor and Ajitkumar Nair
Application No.:	10/809236
Filed:	March 25, 2004
For:	DETACHABLE AND RETRIEVABLE STENT ASSEMBLY
Examiner:	Kathleen C. Sonnett
Group Art Unit:	3731

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Docket No.: S63.2P-11058-US02

REPLY BRIEF

This is a Reply Brief for the above-identified application in response to the Examiner's Answer of September 24, 2009.

A Notice of Appeal was filed in this case on May 29, 2009. An Appeal Brief was filed June 19, 2009. The fees required under §1.17(c) for filing this brief have been addressed. The Commissioner is authorized to charge Deposit Account No. 22-0350 for any other fees which may be due with this Appeal.

Status of Claims

Claims 1, 3, 8-24, 26-30, 33-37, 40, 44, and 45 are pending in this application, stand rejected, and are the subject of this appeal.

Grounds of Rejection to be Reviewed on Appeal

Issue 1: Did the Examiner err in rejecting claims 1, 20-24, 26-30, and 33 under 35 USC § 103 over Callol (US 6,585,757) in view of Globerman (US 6,428,570)?

Issue 2: Did the Examiner err in rejecting claims 1, 3, 20, 23, 24, 26-28, 30, 33, and 40 under 35 USC § 103 over McGuinness (US 6,102,943) in view of Globerman?

Issue 3: Did the Examiner err in rejecting claims 8-11, 13-15, and 34-37 under 35 USC § 103 over Callol in view of Globerman in further view of Bahsiri (US 6,165,178)?

Issue 4: Did the Examiner err in rejecting claim 12 under 35 USC § 103 over Callol in view of Globerman and Bashiri in further view of Camrud (US 6,699,280)?

Issue 5: Did the Examiner err in rejecting claims 16-19, 44, and 45 under 35 USC § 103 over Callol in view of Globerman and Bashiri in further view of Ravenscroft (US 5,702,418)?

Argument

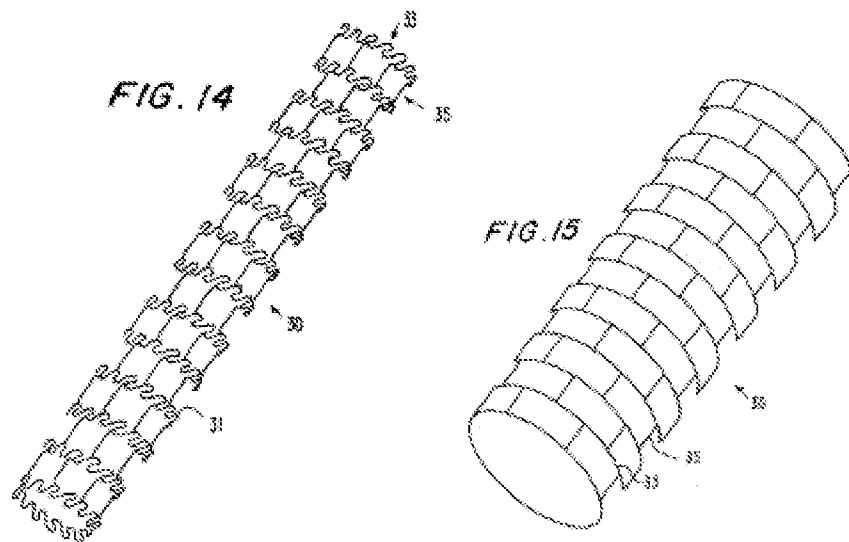
The Examiner continues to assert, as a first rationale for rejecting the claims, that the “curved portions which bridge together two longitudinally extending second stent members on either Callol or McGuinness can be considered an additional element and not one of the claimed interconnected stent members.” Examiner’s Answer, page 10. In an effort to support this assertion, the Examiner provides an analogy, alleging, “that the entire stent of the instant application is interconnected, including the claimed backbone, and yet, the instant application does not considered [sic] the backbone to be one of the interconnected stent members.” *Id.* at 11. The analogy is inapplicable.

Applicants’ claimed backbone is distinguished from the claimed first and second strut members by the language of the claim. Specifically, claim 1 recites in-part, “the stent backbone having a greater column strength than the plurality of interconnected stent members.” In contrast, however, the alleged “bridge” (curved portion of (14) of Callol, curved portion (34)

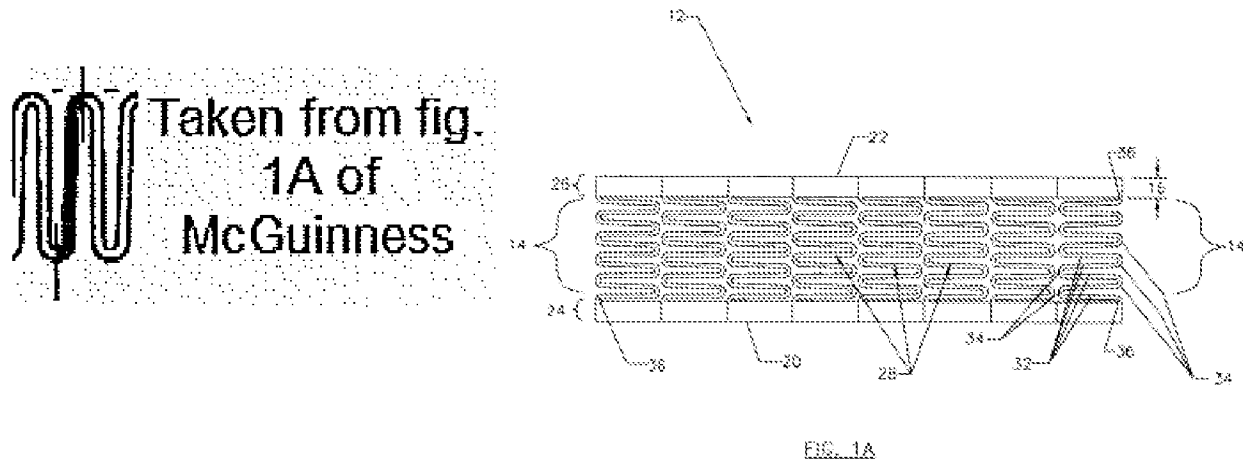
of McGuinness) does not appear to be structurally different from the remainder of the alleged stent member. As admitted in the Examiner's Answer, the so-called "bridges" of Callol and McGuinness are merely "curved portions" of the rings (Callol) or expandable members (McGuinness), respectively. *See e.g.*, page 6 of the Examiner's Answer. In sum, it is erroneous to classify a portion of the expandable members 28 of McGuinness as the claimed stent member, while simultaneously asserting that an immediately adjacent portion of the same expandable member is not a stent member. It is further erroneous to classify a portion of the ring 14 of Callol as a claimed stent member, while simultaneously asserting that an immediately adjacent portion of the same ring is not a stent member.

Applicants' claimed backbone is structurally distinct from the claimed stent members. Because the bridges of Callol and McGuinness are not structurally distinct from the rings (Callol) or expandable members (McGuinness), however, the Examiner's analogy is inapplicable.

With further regard to the Examiner's rejection over McGuinness in view of Globerman, the Examiner admits that "McGuinness also fails to disclose first stent members that are longitudinally directed in the unexpanded and expanded states." *Id.* Thus, the Examiner asserts that "[i]t would have been obvious to add first stent members connecting the second stent members as taught by Globerman . . ." to McGuinness. *Id.* The Examiner identified the first strut members as reference numeral 35 in FIGS. 14, 15 of Globerman shown below.



Seemingly, then, the Examiner's rejection incorporates the alleged first stent members of Globerman with the alleged second stent members of McGuinness, shown below in the Examiner's annotated version of FIG. 1A of McGuinness and FIG. 1A.



A person having ordinary skill in the art would not make the suggested modification. Moreover, even if the suggested modification were made, the resulting stent would be unable to meet the elements of Applicants' claims.

For example, if the longitudinal connectors 35 of Globerman (alleged first stent members) were added to the expandable members 28 of McGuinness (alleged second stent members), the alleged second stent members of the resulting stent would be incapable being "oriented in a substantially circumferential direction in the expanded state," as is claimed. As shown in FIG. 14 of Globerman, the longitudinal connectors are arranged in a peak-to-trough configuration. Connecting the peaks and troughs of McGuinness with the longitudinal connectors 35 would limit the ability of the resulting stent to expand because the alleged backbone 24/26 of McGuinness stent would prevent longitudinal foreshortening. And, although the Abstract of Globerman notes that stent therein disclosed should have "substantially the same length before and after expansion," the resulting stent would be incapable of any significant circumferential expansion, especially to the point where the expandable members 28 of McGuinness could be reasonable classified as having a substantially circumferential orientation. As such, the Examiner's proposed modification would not produce Applicants' claimed stent. Instead, the resulting stent would be unsatisfactory for its intended purpose. *See* MPEP § 2143.01(V) ("If [the] proposed modification would render the prior art invention being modified

unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984))).

Moreover, although Globerman does not disclose peak-to-peak connectors, even if it did, a person having ordinary skill in the art would not modify the stent of McGuinness with such longitudinal connectors. For example, the stent shown above in FIG. 1A is ill-suited to have a longitudinal connectors disposed between the alleged second stent members. Moreover, given the Examiner’s characterization of the expandable members 28, it is unclear how longitudinal connectors could be added to the stent of McGuinness in a peak-to-peak (or trough-to-trough) configuration. Specifically, the Examiner asserts that the expandable members 28 of McGuinness are substantially longitudinally.¹ As such, it is unclear how substantially longitudinal connectors could be added to the stent of McGuinness.

In addition, even if such a stent were made, the stent would not be expected to achieve a “very small unexpanded profile,” as the Examiner suggests on page 6 of the Examiner’s Answer. Instead, adding the longitudinal connectors, especially in a peak-to-peak (or trough-to-trough) configuration, to the stent of McGuinness would increase the size of the unexpanded profile of the stent. As such, a person having ordinary skill in the art would not combine the longitudinal connectors of Globerman with the stent of McGuinness. This modification would render the stent of McGuinness, Globerman, or both unsatisfactory for its intended purpose.

Consequently, a person having ordinary skill in the art would not be motivated to combine the aforementioned references as suggested by the Examiner. Even if the Examiner’s suggested modifications were implemented, however, Applicants’ claims would still define over the asserted combination(s).

¹ Applicants do not acquiesce to the Examiner’s characterization.

Conclusion

For at least the foregoing reasons, claims 1, 3, 8-24, 26-30, 33-37, 40, 44, and 45 are patentable over the cited art. Consequently, reversal of the rejection is respectfully requested.

Respectfully submitted,
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